

Docket No.: **1734-TM-001**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE EXAMINER OF TRADEMARKS

Mark: CRIERI S.R.L.  
Serial No.: 79/152,743  
Filed: April 23, 2014  
Class(es): 14  
Applicant: Crieri SRL  
Law Office: 117  
Examiner: Karen P. Severson, Esq.

New York, NY 10020  
October 20, 2015

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**AMENDMENT**

This Amendment is being filed in response to the Office Action that issued April 20, 2015. Kindly amend the subject application as follows:



**IN THE IDENTIFICATION OF GOODS:**

Please amend the identification of goods in International Class 14 to read as follows:

Fine jewelry and jewelry; articles of fine jewelry and jewelry, namely, bracelets, brooches, cuff links, earrings, pendants, necklaces, rings, tie pins; sculptures made of precious metal; watches and clocks

**REMARKS**

Based on the above amendment and these remarks, Applicant requests that the Examiner reconsider the application, withdraw all objections and allow the application to proceed to publication.

Applicant has amended the identification of goods in Class 14 and requests reconsideration on the issue of the identification.

**REFUSAL UNDER SECTION 2(d):**

Registration of Applicant's trademark, CRIERI, has been refused based on U.S. Registration No. 3822058 for CREARE, the Italian word for "create", for use on various items in class 14.

Applicant's mark, CRIERI, a fanciful term with no known meaning in a foreign language, is also used on various items in class 14, and offers a distinct commercial impression from the cited registration. Applicant respectfully states that the differences in sight, sound and connotation between the marks, as they will be encountered by the purchasing public, as well as the level of sophistication of the purchasers of such goods are sufficient to obviate any possible confusion. Therefore, allowance is proper.

The issue of likelihood of confusion, for registration purposes, is determined by evaluating the factors established in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357,1361, 177 USPQ

563,567 (CCPA 1973). The significance of each factor is determined on the particular circumstances of each case. *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295, 16 USPQ2d 1635, 1637 (Fed. Cir. 1990). One of the most important factors in the instant matter is the dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

When this factor is considered and applied to the present inquiry, it is clear that there is no likelihood of confusion between the Applicant's mark and the cited registration. When assessing the similarities of two marks, the marks must be considered in their entirety. *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239,1240 (Fed. Cir. 1990)

The cited registration and applicant's mark, CRIERI, must be compared for similarities in sound, appearance, meaning or connotation. However, a decision must be made based on the consideration of the overall impression of each mark. *See Sun-Fun Products, Inc. v. Sontan Research & Development, Inc.* 656 F.2d. 186, 213 (5th Cir 1981).

Applicant respectfully disagrees with Examiner's statement that Applicant's mark and Registrant's mark are "essentially phonetic equivalents". (Citation omitted.) Applicant's fanciful mark cannot be pronounced as a phonetic equivalent to the cited registration unless one adopts a speech pattern in which the vowels "E", "I" and "A" are all pronounced the same. As has been mentioned previously in the prosecution, a speech pattern which employs such pronunciations is not attributable to the Italian language, from which the Registrant's mark is derived, nor the English language nor any dialect known to the Applicant. While one may not insist that one pronunciation is "correct" and another is "incorrect" merely for purposes of registration, one is bound by the accepted rules and structure of language. See, e.g., *In re Vittera Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (wherein the court rejected Applicant's contention that the proper pronunciation of their mark XCEED was equivalent to "exceed" while the Registrant's mark X-SEED was properly pronounced a two separate terms "X" and "seed". )

Applicant agrees that if marks are, in fact, phonetic equivalents as in *In re Vittera*, then that may raise an issue of confusion. However, the cases cited in support of this refusal are distinguishable from the instant question.

In addition to *In re Vittera Inc.*, discussed above, Examiner cites *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) wherein the Board held the mark SHAKE SCATTER & GROW for flower seeds was likely to cause confusion with SHAKE-N-GROW registered for use on grass seed; *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar). In each of the cited cases the marks at issue contain the same words, or similar terms in stark contrast to the fanciful mark of the instant Applicant and the Italian mark of the cited registration.

Applicant also respectfully disagrees with the suggestion that Applicant's fanciful mark, CRIERI conveys the same idea, or same overall meaning as Registrant's mark CREARE (Create). (Citations omitted.) Nevertheless, again the line of cited cases in support of such a premise is distinguishable from the instant matter. The Applicant's mark is a fanciful mark, without a definition. While in each of the following cases cited by the Examiner, the marks are well known words with accepted definitions. See, *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); see *In re M. Serman & Co.*, 223 USPQ 52, 53 (TTAB 1984) (holding CITY WOMAN for ladies' blouses likely to be confused with CITY GIRL for a variety of female clothing); *H. Sichel Sohne, GmbH v. John Gross & Co.*, 204 USPQ 257, 260-61 (TTAB 1979) (holding BLUE NUN for wines likely to be confused with BLUE CHAPEL for the same goods); *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125, 128 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN

OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105, 109 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services).

Rather than considering the similarities between components of marks one must evaluate the impression that each mark, in its entirety, is likely to have on a purchaser exercising the attention usually given by purchasers of such products. *Duluth News-Tribune v. Mesabi Publishing Co.*, 38USPQ2d 1937, 1940 (8<sup>th</sup> Cir. 1996).

Applicant respectfully requests reconsideration of the refusal to register based on the differences in the marks as set forth above and the differences in the respective goods.

Based on the foregoing, Applicant respectfully requests that the refusal to register be reconsidered and withdrawn. Applicant submits that the differences in the marks and the respective goods will obviate any possibility of confusion.

It is requested that the Examiner contact the undersigned with any questions.

Respectfully submitted,  
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Commissioner for Trademarks  
P.O. Box 1451  
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on October 20, 2015

/Kathleen A. Costigan/

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